



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/568,992

02/21/2006

Jurgen Meyer

032301.443

1784

441

7590

08/12/2011

SMITH, GAMBRELL & RUSSELL

1130 CONNECTICUT AVENUE, N.W., SUITE 1130

WASHINGTON, DC 20036

EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

08/12/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/568,992

**Applicant(s)**

MEYER ET AL.

**Examiner**

COURTNEY BROWN

**Art Unit**

1617

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 August 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
 NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 11.

Claim(s) rejected: 1,3,5,7,9 and 14.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/JANET L. EPPS -SMITH/  
Primary Examiner, Art Unit 1633

Continuation of 11. does NOT place the application in condition for allowance because:

The examiner maintains the rejection of claims 1, 3,5,7,9 and 14 under 35 U.S.C. 103(a) as being unpatentable over Kerner et al. (US 2002/0168524 A1) in view of each Mitchnick et al. (US Patent 5,486,631), Korth et al. (US Patent 7,186,768) and Katusic et al. (US Patent 7, 718261) and the objection of claim 11 for reasons of record. Applicant's arguments have been fully considered, but are not found persuasive.

Applicant argues that the Examiner has assembled various references which deal with metal oxides or silanization and that neither reference teaches the invention or the improved zinc oxide ingredient. Applicant argues that the SPF values, disclosed, show benefits for the active zinc oxide active ingredient and that even if one views the claimed nanoscale zinc oxide ingredient as an intermediate and the formulation as the final product, some weight should be given to the intermediate when considering the unexpected SPF values shown for the exemplified formulations. Applicant further argues that claim 1 describes a surface-modified nanoscale pyrogenically produced zinc oxide powder characterized as comprising aggregates and as having the following physico-chemical characteristics: BET surface areas: 18 4- 5 mVg; C content: 0.5 to 1.0 wt.%; average diameter: 50 to 300 nm and a shape factor F (circle) of below 0.5, where the surface modification is specified as silanization through the use of specified agents and that some weight should be given to the unexpected results shown for the exemplified sunscreen formulation. However, the Examiner is not persuaded by Applicant's arguments. The Examiner maintains the position that the results presented in Tables 3-10 of the instant specification are not material to the instant claims 1,3,5,7, 11 and 14 because the claims are drawn to a surface-modified pyrogenically produced zinc oxide powder and not to a sunscreen composition. Furthermore, while claim 9 is drawn to a sunscreen composition, the recited genus of "of dermatologically acceptable carrier" is very broad and the provided evidence is not commensurate in scope with this broadly claimed genus. Therefore, the results are not commensurate in scope with the claims. Objective evidence of nonobviousness, if any, must be commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356 (CCPA 1972).

The amendment of claim 1 has been submitted adding the new limitation of "nanoscale" which is taught by Katusic et al. (see figure 1).

Thus, the rejection is maintained for reasons of record and the foregoing commentary.  
Refer to the Final rejection, mailed on May 10, 2011.

Claim 11 remains objected and claims 1, 3,5,7,9 and 14 remain rejected.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Fereydoun Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown  
Patent Examiner  
Technology Center 1600  
Group Art Unit 1617